

REMARKS

Reconsideration and allowance of the present application are respectfully requested. Claims 1-6 remain pending in the application. By this amendment, a substitute Abstract and replacement drawings (Figs. 1 and 2) are provided. No new matter is added.

On page 2 of the Office Action, the Examiner objects to the drawings (Figs. 1 and 2). To obviate the objection, replacement drawings (Figs. 1 and 2) are corrected with a legend --Conventional Art--. Withdrawal of the objection to the drawings is respectfully requested.

On page 2 of the Office Action, the Examiner objects to the specification (abstract) of the disclosure. A substitute abstract is provided to obviate the objection. Withdrawal of the objection to the specification is respectfully requested.

On page 2 of the Office Action, claims 1-5 are rejected as being unpatentable over U.S. Patent No. 5,075,515 (Yoneda et al.) in view of JP A 09-312955 (Kamoshita), U.S. Patent No. 6,585,553 (Fetridge et al.), or U.S. Patent Application Publication US 2004/0090070 (Eisenbraun); and on page 3 of the Office Action, claims 1-6 are rejected as being unpatentable over U.S. Patent No. 5,342,048 (Jones et al.) in view of the Kamoshita reference, the Fetridge et al. patent, or the Eisenbraun publication. These rejections are respectfully traversed.

The Yoneda et al. patent and the Jones et al. patent do not teach or suggest a slot car toy powered by a manually driven electrical power generating means as recited in claim 1. On page 3 of the Office Action, the Examiner admits that the Yoneda et al. patent and the Jones et al. patent do not disclose a manually driven electrical power generating means.

AMENDMENTS TO THE DRAWINGS:

The attached sheets of drawings include changes to Figs. 1 and 2. These two sheets, which include Figs. 1 and 2, replace the original two sheets including Figs. 1 and 2. In Figs. 1 and 2, the drawings are labeled "Conventional Art."

On page 3 of the Office Action, the Examiner asserts that the Kamoshita reference, the Fetridge et al. patent, and the Eisenbraun publication teach a manually driven electrical power generating means used to supply electrical power to a toy. The Examiner then concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a manually driven electrical power generating means as allegedly taught by the Kamoshita reference, the Fetridge et al. patent, and the Eisenbraun publication to the slot car racing systems of the Yoneda et al. patent and the Jones et al. patent for the purpose of powering the respective slot cars. Applicant respectfully disagrees with the Examiner's ultimate conclusions.

The prior art does not teach or suggest incorporating a manually driven electrical power generating means with an electrically powered slot car racing system as recited in claim 1. Furthermore, the prior art does not teach or suggest incorporating a hand, foot, or treadmill operated generator to power the toy cars, as respectively recited in claims 2-4. Rather, to one of ordinary skill, the idea of a powered slot car racing system that requires physical effort and exertion would seem contradictory to the prevailing trend towards battery (or mains) powered toys, and requiring a player's physical effort and exertion would be perceived as a regression backwards from the trend towards a battery (or mains) powered car.

However, applicant has discovered that using a hand or foot operated generator to drive a slot car uniquely adds an extra degree of interest to slot car racing. The Kamoshita publication relates merely to switching of power circuits using contact plates; the Fetridge et al. patent merely relates to a toy building set having a separable energy source block; and the Eisenbraun patent relates to a manually-

operated device for supplying electricity to phones, flashlights and toys. In contrast, in the claimed slot car racing system, two (or potentially more) children can play together and against each other. With the claimed slot car system having at least one slot, one child can race another.

With the prior art slot cars that are driven electrically from mains or battery sources, a child can go faster than another simply by varying the current supplied to the cars using a speed controller without any real physical exertion. The prior art limits the test of driving skill to cornering, i.e., adjusting the speed of the cars as they go around bends and corners so that they do not leave the track.

In contrast, the claimed slot car system incorporating a manually driven electrical power generating means provides an added element of speed control. As claimed, the manually driven electrical power generating means raises the interest of the child racer. For example, the basic speed of the car will depend upon how vigorously the child racer generates the power to the cars by physical effort and exertion. Applicant discovered that this can add an extra degree of competition.

When applying 35 U.S.C. §103, the references must suggest the desirability of making the combination, and must be viewed without the benefit of impermissible hindsight. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986). See also MPEP §2143 regarding the basic criteria for establishing a prima facie case of obviousness. The Examiner has not met the burden of pointing out the suggestion of the desirability of making the combination in the applied references. Further, the references do not appear to be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ 2d 1443, 1445 (Fed. Cir. 1992).

There has been no showing of support for the conclusion that it would have been obvious to incorporate a manually driven electrical power generating means with an electrically powered slot car racing system as the Examiner asserts. The Office Action does not identify any teachings in the references that would lead one having ordinary skill in the art at the time the invention was made to incorporate a manually driven electrical power generating means, as allegedly taught by the Kamoshita reference, the Fetridge et al. patent, and the Eisenbraun publication, to the slot car racing systems of the Yoneda et al. patent and the Jones et al. patent for the purpose of manually powering the cars in a competitive environment. Only Applicant teaches that by incorporating a manually driven electrical power generating means the basic speed of the slot car will depend upon how vigorously the child racer generates the power to the slot cars by physical effort and exertion. Applicant further discovered that the physical effort and exertion can add an extra degree of competition between children. Applicant also discovered that the car as manually powered is also potentially safer and is more readily portable.

Regarding claim 5, the Office Action provided no detailed basis for the obviousness-based rejections of claim 5. The Yoneda et al. patent and the Jones et al. patent, considered individually or in combination with the Kamoshita reference, the Fetridge et al. patent, or the Eisenbraun publication, do not render obvious the slot car system at least for the above reasons, and for the additional features of a plurality of tracks each having a respective manually driven electrical power generating means as recited in claim 5.

For at least the foregoing reasons, Applicant's claim 1 is allowable over the Yoneda et al. patent and the Jones et al. patent, considered individually or in

combination with the Kamoshita reference, the Fetridge et al. patent, or the Eisenbraun publication. The remaining claims depend from independent claim 1 and recite additional advantageous features which further distinguish over the documents relied upon by the Examiner. As such, the present application is considered in condition for allowance.

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the application is in condition for allowance and a Notice of Allowance is respectfully solicited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: _____

Richard J. Kim

Registration No. 48,360

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620